

REMARKS

This Reply under 37 C.F.R. §1.111 is being submitted in response to the outstanding Office Action mailed November 14, 2006. In view of the following remarks, reconsideration and allowance of this application are respectfully requested.

In the Office Action, claims 1 – 38 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action contends that “bonding with the surface can be formed if such substrate surface is actually part of the structure that is claimed. Stating that a coating is ‘for’ substrate surface does not make such surface part of the structure.” (Office Action, page 2). Therefore, claim 1 is amended to clarify that the bonding agent is capable of producing a bond between platelet-shaped pigments, binding agent, and the cellulose-bearing substrate. No new matter is added.

Additionally, claims 1 – 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Carpenter et al. (EP 0717088). The Office Action states that Carpenter et al. “does not specifically name a binding agent. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select compounds that would physically and chemically bind elements of the composition” (Office Action, page 3). This rejection is respectfully traversed for the following reasons.

Claims 1-38 are directed to coating agents having a bonding agent capable of producing a bond between platelet-shaped pigments, a binding agent, and a cellulose-bearing substrate surface. (Emphasis added). It is noted on page 4, lines 6-14 of the present application that:

The use of a bonding agent which provides a bond between platelet-shaped pigments, binding agent and the cellulose-bearing substrate surface provides that the platelet-shaped pigments are surprisingly reliably fixed on the substrate surface. It has been found that a coating produced using the coating agent according to the invention is extremely stable and resistant under open-air weathering conditions over a period of several years, for example more than between five and six years. This surprising stability of the coating is attributed to the excellent bond between the platelet-shaped pigments, the cellulose-bearing surface and the binding agent.

Carpenter et al. does not disclose or suggest this type of bonding agent, specifically, a bonding agent capable of producing a bond between platelet-shaped pigments, a binding agent, and a cellulose-bearing substrate surface. Additionally, the Office Action does not provide any evidence that a reasonable expectation of success exists in the prior art for the incorporation of a bonding agent capable of producing a bond between platelet-shaped pigments, a binding agent, and a cellulose-bearing substrate surface into the coating agent of Claim 1 in view of Carpenter et al. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” (M.P.E.P. §2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Accordingly, claims 1 – 38 are not obvious in view of Carpenter et al. under 35 U.S.C. §103(a). Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

In view of the foregoing remarks, this application is now in condition for Allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

Finally, if there are any additional charges, the Examiner is authorized to charge applicants’ Deposit Account No. 19-5425 therefore.

Respectfully submitted,

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